

be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). Lesthievent fails to teach at least the tap selection circuit of claim 1. Therefore, in order to establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the art to modify Lesthievent so that one of Lesthievent's filter circuits has a tap selection circuit. M.P.E.P. § 2143.

In an attempt to show the alleged suggestion or motivation to modify the circuitry of Fig. 4 of Lesthievent so that the circuitry includes the missing tap selection circuit, the Examiner contends that the circuitry of Fig. 4 performs the function that is recited in lines 4 and 5 of claim 1. However, even assuming, *arguendo*, that this circuitry does perform the function that is recited for the tap selection circuit of claim 1, neither the language describing this circuitry nor any other language of Lesthievent provides a suggestion or motivation to modify this circuitry to transform this circuitry into a tap selection circuit. In essence, the Examiner is improperly reading the "tap selection" language out of the claim. However, as set forth above, all claim limitations must be considered. *In re Wilson*, 165 USPQ at 496. Thus, Lesthievent does not teach a tap selection circuit and does not provide a suggestion or motivation to modify one of its filters to include a tap selection circuit.

Thus, for at least the reasons set forth above, withdrawal of the § 103(a) rejection of independent claim 1 is requested. Claims 2, 3 and 9-11 are patentable for at least the reason that these claims depend from an allowable claim.